



UNITED STATES DEPARTMENT OF COMMERCE
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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/210,653	03/10/94	MICHELSON	G P10936IV

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HANLON, B. EXAMINER	
ART UNIT	PAPER NUMBER
3301	15

DATE MAILED:

11/30/94

Below is a communication from the EXAMINER in charge of this application

COMMISSIONER OF PATENTS AND TRADEMARKS

ADVISORY ACTION

☒ THE PERIOD FOR RESPONSE:

- ☒ is extended to run 4 months from the date of the Final Rejection
- ☐ continues to run _____ from the date of the Final Rejection
- ☐ expires three months from the date of the final rejection or as of the mailing date of this Advisory Action, whichever is later. In no event however, will the statutory period for response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date that the shortened statutory period for response expires as set forth above.

☒ Appellant's Brief is due in accordance with 37 CFR 1.192(a).

☒ Applicant's response to the final rejection, filed 11-14-94, has been considered with the following affect, but it is not deemed to place the application in condition for allowance:

1. ☒ The proposed amendments to the claim and/or specification will not be entered and the final rejection stands because:
- ☐ There is no convincing showing under 37 CFR 1.116(b) why the proposed amendment is necessary and was not earlier presented.
 - ☒ They raise new issues that would require further consideration and/or search. (See Note).
 - ☒ They raise the issue of new matter. (See Note).
 - ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
 - ☒ They present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: Applicant's amendment raises a question of new matter. This amendment would also cause new search and further consideration by adding new Claims 16-18.

2. ☐ Newly proposed or amended claims _____ would be allowed if submitted in a separately filed amendment cancelling the non-allowable claims.
3. ☒ Upon the filing of an appeal, the proposed amendment ☐ will be ☒ will not be, entered and the status of the claims in this application would be as follows:
- Allowed claims: _____
- Claims objected to: _____
- Claims rejected: 9, 11, 12, 14 and 15
- However;
- ☐ The rejection of claims _____ on references is deemed to be overcome by applicant's response.
 - ☐ The rejection of claims _____ on non-reference grounds only is deemed to be overcome by applicant's response.
4. ☐ The affidavit, exhibit or request for reconsideration has been considered but does not overcome the rejection.
5. ☐ The affidavit or exhibit will not be considered because applicant has not shown good and sufficient reasons why it was not earlier presented.
- ☐ The proposed drawing correction ☐ has ☐ has not been approved by the examiner.
- ☐ Other

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ART UNIT 331

Art Unit: 3301

The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as the specification, as originally filed, does not provide support for the invention as is now claimed.

The specification does not supply support for the limitation that the projections are disposed along substantially the entire length of the shaft. Neither the drawings or the specification provide support for this limitation.

Claims 14 and 15 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

Claims 9,11,12,14 and 15 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The rejections of claims 9,11 and 12 set forth in the first Office Action, paper #3, are maintained by the examiner for applicant has not addressed or obviated said rejections. The following rejections also apply:

Art Unit: 3301

Claims 14 and 15 are rejected for applicant's claiming that the projections are closely spaced is vague. It is not understood what type of distance applicant is claiming by the use of such a phrase. "Close" is a relative term and without some gauge for this term to be relative to, this type of distance is vague. Claim 14 is also rejected for the scope of the phrase "along substantially the entire length" is not understood by the examiner. This phrase has not support in the specification or the drawings, thus it can not be understood by the examiner.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --
(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 9,11,12 and 14 are rejected under 35 U.S.C. § 102(E) as being anticipated by Bays et al.

The discussion of Bays et al. in relation to claims 9,11 and 12 can be found in the first office action.

In relation to claim 14, the projections are closely spaced to one another for closely spaced is a relative term. Also, Bays et al discloses that their projections are along substantially the entire length of the shaft for Bays et al teach that the projections are over more than two-thirds of the shaft.

Art Unit: 3301

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claim 15 is rejected under 35 U.S.C. § 103 as being unpatentable over Bays et al. Bays et al teach that the projections may number more than three. They teach that the projections may be as few as one and more than three. (column 4, lines 62-66) Therefore, the modification to make the rivet with five projections would have been an obvious choice of design in view of the teachings of Bays et al.

Claims 9,11,12,14 and 15 rejected under 35 U.S.C. § 103 as being unpatentable over Bays et al. in view of Chisholm et al.

The substance of this rejection can be found in the first office action, paper #3.

Applicant is to note that the examiner interprets the "absorbable material" of claim 9 to mean bioabsorbable material.